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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/049,656 | 02/13/2002 | Hubert Baumgart | IN-5554 | 7707 |
| 26922 | 7590 | 03/22/2004 | EXAMINER | |
| BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442 | | | SERGEANT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,656

Applicant(s)

BAUMGART ET AL. 

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 21-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "positionally isomeric", when recited without specific reference to the actual isomer, renders the claims indefinite, because it is unclear what meaning or purpose is conveyed by the language. How is "positionally isomeric diethyloctanediol" different from diethyloctanediol?

Throughout the claims, the species denoted by the language, "at least one of", should be recited in the alternative, because the language, as claimed, can be interpreted to require the presence of all recited species.

Within claim 30, it is unclear how the language, "and the form of crosslinked microparticles", is to relate to the rest of the claim.

Within claim 34, it is unclear how "decorative" or "protective" is to further limit "coating". All coatings are considered to be protective, and it is unclear what criteria must be met in order for the coating to be considered decorative.

The language and/or form of claim 38 is ambiguous to the extent that the claim is essentially meaningless. At the very least, the claim is incomplete.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 21, 22, 24, 27-31, and 33-39 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/15725.

The reference discloses coating compositions wherein diethyloctanediol is disclosed as a reactant. See page 15, line 10. Though the reference fails to disclose the particular isomer, the claims are considered to be met, because the claims encompass all position isomers.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 21-39 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19826715.

The reference discloses coating compositions derived from 2,4-diethyloctane-1,5-diol. See abstract.

6. Claims 21, 22, 24, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 778924.

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The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85.

7. Claims 21-39 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 940459.

The reference discloses coating and adhesive compositions derived from various diethyloctanediols, including 2,4-diethyloctane-1,5-diol. See page 2 and claims.

8. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

9. Claims 21-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/15725 or DE 19826715 or GB 778924 or EP 940459.

As aforementioned, the references disclose the use of diethyloctanediol in the production of polymers, suitable for use as coatings and adhesives.

10. Though the references fail to disclose each of applicants' claimed isomers, the position is taken that it would have been obvious to utilize any isomer of diethyloctanediol in the production of polymers, based upon the teachings of the references. It has been held that a compound that is isomeric with a compound of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound. *In re Norris*, 84 USPQ 458, 179 F2d 970 (CCPA 1950); *In re Finely*, 81 USPQ 383 and 387, 174 F2d 130 (CCPA 1949).

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.

R. Sergent
March 15, 2004


RABON SERGENT
PRIMARY EXAMINER